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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.												
10/810,983	03/26/2004	Yar-Ming Wang	GP-304670	. 9619												
7590 12/12/2007																
Kathryn A. Marra General Motors Corporation Mail Code 482-C23-B21 PO Box 300 Detroit, MI 48265-3000		<table border="1"><tr><td colspan="2">EXAMINER</td></tr><tr><td colspan="2">MAYEKAR, KISHOR</td></tr><tr><td>ART UNIT</td><td>PAPER NUMBER</td></tr><tr><td>1795</td><td></td></tr><tr><td>MAIL DATE</td><td>DELIVERY MODE</td></tr><tr><td>12/12/2007</td><td>PAPER</td></tr></table>			EXAMINER		MAYEKAR, KISHOR		ART UNIT	PAPER NUMBER	1795		MAIL DATE	DELIVERY MODE	12/12/2007	PAPER
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/810,983	<b>Applicant(s)</b> WANG ET AL.	
	<b>Examiner</b> Kishor Mayekar	<b>Art Unit</b> 1795	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-29 is/are pending in the application.  
     4a) Of the above claim(s) 21-29 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
     a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>03/04</u> . | 6) <input type="checkbox"/> Other: ____.  |

## DETAILED ACTION

### *Election/Restrictions*

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-20, drawn to a method of separating adhered matter from a surface of a conductive substrate, classified in class 205, subclass 705.
  - II. Claims 21-29, drawn to a method of applying coating onto a surface of a vehicle part, classified in class 204, subclass 471.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions of Groups I and II are directed to related different processes. The related inventions are distinct if the (1) the inventions as claimed are either not capable of use together or can have a materially different design, mode of operation, function, or effect; (2) the inventions do not overlap in scope, i.e., are mutually exclusive; and (3) the inventions as claimed are not obvious variants. See MPEP § 806.05(j). In the instant case, the inventions as claimed have mode of operation. Furthermore, the inventions as claimed do not encompass overlapping subject matter and there is nothing of record to show them to be obvious variants.

3. Because these inventions are independent or distinct for the reasons given above and there would be a serious burden on the examiner if restriction is not required because the inventions require a different field of search (see MPEP § 808.02), restriction for examination purposes as indicated is proper.

4. During a telephone conversation with Attorney Anna Budde on 28 November 2007 a provisional election was made with traverse to prosecute the invention of Group I, claims 1-20. Affirmation of this election must be made by applicant in replying to this Office action. Claims 21-29 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

5. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

#### *Specification*

6. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of

the following is required to the claimed subject matter of each of claims 2, 9 and 11 .

***Claim Rejections - 35 USC § 112***

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 14-16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 14-16 are indefinite because the claims are lacking antecedent basis for the recitation "the electrolyte medium".

***Claim Rejections - 35 USC § 102 and § 103***

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 1, 2, 4-10, 14, 15, 18 are rejected under 35 U.S.C. 102(b) as being anticipated by Polan et al. (US 4,568,431). Polan's invention is directed to a process for producing electroplated and/or treated metal foil. Polan discloses that the process comprises an electrolytic cleaning as a pretreatment step (col. 5, lines 3-68), the provision a surface impurity removing means including a skimmer floating on the surface of a treating solution in the tank and/or an overflow system for removing solution from the tank and passing it through an off-line solution filtration/replenishment loop (col. 2, lines 39-55), and the continuous withdrawal of solution from tank 14 (Fig. 2). As such, Polan's teachings anticipate the above claims.

12. Claims 17, 19 and 20 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Polan '431. Polan as applied above disclose that acid cleaning in addition to the caustic cleaning may be used (col. 5, lines 64-68) and the current density (col. 5, lines 45-63). It has been held that the disclosure in

the prior art of any value within the claimed range is an anticipation of that range. And a prima facie case of obviousness exists in the case where the claimed range overlaps range disclosed by the prior art, *In re Wertheim* 191 USPQ 90.

13. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Polan '431 in view of Lauke (US 4,568,438) . Polan as applied above further discloses in col. 9, line 56 through col. 10, line 54 the continuous withdrawal of the solution to remove the surface impurities or contaminants from the treatment tank 14. The difference between polan and the instant is the provision of the recited eductor. Lauke teaches in a method for making an electroimmersion finish the limitation (Figs. 1 and 2). The subject matter as a whole would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified Polan's teachings as shown by Lauke because the selection of any of known recirculation of the solution with contaminant removal would have been within the level of ordinary skill in the art.

14. Claims 11-13 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Polan '431 over Sallo et al. (US 3,668,090) or Smith (US 4,270,986) . The difference between Polan as applied above and the instant claims is the recited voltage and electrolyte medium. Sallo teaches in a method of electroalkaline cleaning process of ferrous strands the limitations (col. 1, line 51 through col. 2, line 52). Smith teaches the

same in a method for soldering aluminum (paragraph 2). The subject matter as a whole would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified Polan's teachings as shown by either Sallo or Smith because the selection of voltage and electrolyte medium for the cathodic cleaning would have been within the level of ordinary skill in the art.

#### *Conclusion*

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kishor Mayekar whose telephone number is (571) 272-1339. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nam Nguyen can be reached on (571) 272-1342. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

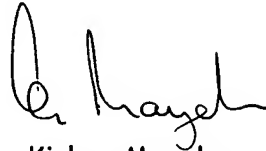
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Representative or access to the automated information system, call 800-786-9199 (IN  
USA OR CANADA) or 571-272-1000.

A handwritten signature in black ink, appearing to read 'K Mayekar', written in a cursive style.

Kishor Mayekar  
Primary Examiner  
Art Unit 1795